

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re \_\_\_\_\_

Decision on  
Petition for Regrade  
Under 37 C.F.R. § 10.7(c)

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**MEMORANDUM AND ORDER**

(Petitioner) petitions for regrading his answers to questions 7, 16, 20, 38 and 43 of the morning session and questions 31, 38, 41, and 42 of the afternoon session of the Registration Examination held on April 21, 1999. The petition is denied to the extent Petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in the Registration Examination. Petitioner scored 62. On August 4, 1999, Petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

**OPINION**

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect

answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of Petitioner’s arguments have been considered. Each question in the examination is worth one point.

Petitioner has been awarded points for morning questions 20, 43, and 45 and afternoon questions 28 and 38 because these questions have been eliminated from the examination.

Accordingly, Petitioner has been awarded an additional five points on the examination, resulting in a regraded score of 67. However, no credit has been awarded for morning questions 7, 16, and 38 and afternoon questions 31, 41, and 42.

Morning question 7 reads as follows:

7. A patent application claims a chemical composition and discloses in the application that the composition has a cleansing property in addition to being able to remove ink stains. The examiner rejected the claims in the application under 35 U.S.C. § 103 as being obvious over Parker in view of Cross. Each reference discloses chemical compositions which can be used to remove ink stains. The proposed combination of references includes all of the limitations of the composition claimed in the application. However, neither reference shows or suggests the cleansing property newly discovered by applicant. Does the combination of Parker and Cross support a *prima facie* case of obviousness?

- (A) Yes, even though neither reference shows or suggests the newly discovered property of the claimed composition.
- (B) Yes, because after reading applicant's specification, it would be obvious that both references can be combined to achieve the cleansing property claimed by applicant.
- (C) No, unless in addition to structural similarity between the claimed and prior art compositions, the references contain a suggestion that the compositions will have the newly discovered cleansing property.
- (D) No, because the discovery of a new property of a previously known composition imparts patentability to the known composition.
- (E) No, because the burden of proof cannot be shifted to the applicant to show that the prior art compositions lacked the newly discovered property asserted for claimed composition unless one of the references discloses the property.

(A) is the correct answer because it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. MPEP § 2144, page 2100-115, right hand column.

Petitioner contends choice (C) is the correct answer and choice (A) is incorrect.

Petitioner argues that since neither reference shows or suggests the cleansing property, “the Examiner will fail to meet the initial burden of establishing a *prima facie* case for obviousness” in the fact pattern presented in the question. Petitioner further argues that choice (C) is correct because the combination of the reference does not support a *prima facie* case of obviousness

unless the references contain a suggestion that the compositions will have the newly discovered cleansing property.

A better answer than any offered would have been “(F) No, unless there is a suggestion or motivation to modify the reference or to combine reference teachings.” Since this was not one of the answers provided, the next best answer was (A). Selection (A) demonstrates that the test-taker understands that a prima facie case of obviousness does not require the same reason to combine (e.g., to have a cleansing property) as shown in the patent application.

While petitioner’s arguments explain why answer (F) proposed above would have been a better answer, petitioner’s argument that answer (C) was the best answer is not persuasive.

Answer (C) suggests that the references have to contain a suggestion that the compositions will have the newly discovered property, which is wrong. If discovery of a new property were enough to overcome a showing of obviousness, then an inventor would just have to identify a new characteristic of the combination and a hundred other reasons to combine teachings could be disregarded. A new property is not, however, enough to overcome a prima facie case or obviousness. It is sufficient that the prior art disclose one reason for combining the references. See *In re Baxter Travenol Labs*, 952 F.2d 388, 21 USPQ 1281 (Fed. Cir. 1991)(mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention). Furthermore, choice (C) is incorrect because structural similarity is not a requirement. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 16 reads as follows:

16. Pete the patent practitioner is preparing a patent application for his client, Perry. The invention is disclosed in the specification as a pickle machine comprising A, B, and means C for performing a function. The specification discloses two specific embodiments for

performing the function defined by means C, namely C' and C". The specification also discloses that components D or E may be combined with A, B, and means C to form A, B, means C, and D, or to form A, B, means C and E. The specification further discloses that component G may be used with only means C', and then only if components D and E are not present.

The first three claims in the application are as follows:

1. A pickle machine comprising A, B and means C for performing a function.
2. A pickle machine as claimed in Claim 1, wherein means C is C'.
3. A pickle machine as claimed in Claim 1 or 2 further comprising D.

Which of the following would be a proper claim 4 and be supported by the specification?

- (A) A pickle machine consisting essentially of A, B, means C' for performing a function, D, and G.
- (B) A pickle machine as claimed in Claim 2, further comprising E.
- (C) A pickle machine as claimed in Claim 1, further comprising D.
- (D) A pickle machine as claimed in Claim 2 or 3, wherein means C is C", and further comprising G.
- (E) A pickle machine as claimed in Claims 1, 2, or 3, further comprising G.

The correct answer is choice (B) because the specification fully supports a pickle machine comprising A, B, C', and E. The specification discloses "A, B, and means C for performing a function." The specification further teaches that C can be C' or C", and that component E may combined with A, B and C to form A, B, C, and E. Accordingly, a pickle machine comprising A, B, C' (one of the two species of C) and E is fully supported by the specification.

Petitioner contends choice (B) is not correct. Petitioner argues "[w]hile A, B, means C and E is fully supported by the specification, A, B and means C' and E is not supported by the specification."

Petitioner's argument is not persuasive. Since the specification discloses A, B, C and E, and that C may be C', the specification discloses A, B, C' and E. Under 35 U.S.C § 112, paragraph six and *In re Danaldson*, 16 F.3d 1189, 29 USPQ 2d 1845 (1994) (*in banc*), a means-

plus-function clause is limited to the corresponding structure disclosed in the specification. Here, the specification discloses C' performing the function defined by means C. Therefore, C' may properly substitute means C. Accordingly, choice (B) is the correct answer because the specification fully support the claim. No error in grading has been show. Petitioner's request for credit on this question is denied.

Morning question 38 reads as follows:

38. You are a registered patent agent representing a corporate client. An appeal is taken from the examiner's final rejection of Claims 1-8 of your client's nonprovisional patent application. Independent Claim 1 and its dependent Claims 2-4 stand rejected under 35 U.S.C. § 102(b) based on a U.S. patent to X. Independent Claim 5, independent Claim 6 and its dependent Claims 7-8 stand rejected under 35 U.S.C. § 103 based on a U.S. patent to Y in view of a U.S. patent to Z. None of the dependent claims are multiple dependent claims. The subject matter of Claims 1, 2, 3, 5, 6 and 8 is very important to your client and you consider each of these claims to be separately patentable over the art applied by the examiner in these claims. In your Appeal Brief, which of the following courses of action, if any, would be the most appropriate to follow on behalf of your client?

- (A) Specify that dependent Claims 2-4 and 7-8 stand or fall together with their respective independent Claims 1 and 6, and present reasons as to why independent Claims 1, 5, and 6 are considered separately patentable.
- (B) Point out the errors in the examiner's rejection of Claims 1-3 and how the specific limitations of Claims 1-3 are not shown in X's patent. Point out the errors in the examiner's rejection of Claims 5, 6, and 8 and how Y and Z, taken as a whole, do not suggest the claimed subject matter of Claims 5, 6, and 8.
- (C) Point out that dependent Claims 4 and 7 stand or fall with their respective independent Claims 1 and 6, and present arguments as to the separate patentability of each of Claims 1, 2, 3, 5, 6, and 8.
- (D) Argue the importance of each claim to your client, emphasizing the differences in what independent Claims 1, 5, and 6 cover, and state how the examiner erred in relying on X, Y, and Z's patents.
- (E) All of the above.

Choice (C) is the most correct answer. The facts in the question provides "[t]he subject matter of Claims 1, 2, 3, 5, 6 and 8 is very important to your client and you consider each of these claims to be separately patentable over the art applied by the examiner in these claims."

Achieving the client's objective, choice (C) provides a statement, "dependent Claims 4 and 7 stand or fall with their respective independent Claims 1 and 6", that complying with 37 CFR § 1.192(c)(7). Also, arguments are included on the separate patentability of each of Claims 1, 2, 3, 5, 6 and 8 complying with 37 CFR § 1.192(c)(8).

Petitioner contends credit should be given equally to choice (B) and (C) because they are merely "in part correct." Petitioner argues that "there is insufficient response regarding to the examination's rejection; namely, answer (C) does not address the stand rejection 35 U.S.C. § 102(b) and also stand rejection under 35 U.S.C. § 103." Petitioner further maintains "[t]he most correct answer is one that would 1) point out the error in the examiner's rejection as well as 2) present arguments as to the separate patentability of each of the Claims." Petitioner concluded choice (B) is equally "in part correct" since it addresses the errors that the Examiner has made but did not address the separate patentability of each claims."

Petitioner's arguments are not persuasive. As explained in MPEP § 1206, "[i]f an appealed ground of rejection applies to more than one claim and appellant considers the rejected claims to be separately patentable, 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together, and to present in the appropriate part or parts of the argument under 37 CFR 1.192(c)(8) the reasons why they are considered separately patentable." MPEP § 1206 further sets forth "[t]he absence of such a statement and argument is a concession by the applicant that, if the ground of rejection were sustained as to any one of the rejected claims, it will be equally applicable to all of them." Choice (B) does not have a statement of which claims of the group do not stand or fall together as required by 37 CFR § 1.192(c)(7). Furthermore, choice (B) assumes facts not presented. Specifically, "limitations of Claims 1-3 are not shown in X's patent"

and “Y and Z, taken as a whole, do not suggest the claimed subject matter of Claims 5, 6, and 8.”

Assumption of facts not presented in the question is a violation of the Examination Directions.

Accordingly, choice (B) is not correct.

Contrary to Petitioner’s contention that choice (C) is “in part correct”, choice (C) is the only answer that provides a statement in compliance of 37 CFR § 1.192(c)(7) and presents arguments as to the separate patentability of each of Claims 1, 2, 3, 5, 6, and 8 which are very important to the client. Thus, choice (C) is the most correct answer. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 31 reads as follows:

31. An acceptable Notice of Appeal is timely filed in the PTO on March 23, 1999. Absent extraordinary circumstances, which of the following is the **last day** that an appeal brief can be filed if a proper petition and the necessary fees for the brief and extension of time are filed with the brief?

- (A) April 8, 1999
- (B) Monday, October 25, 1999
- (C) August 23, 1999
- (D) Monday, May 24, 1999
- (E) September 23, 1999

Choice (B) is the correct answer. Monday, October 25, 1999 is the latest date that an appeal brief can be filed based on a March 23, 1999, Notice of Appeal filing date. The two month period from the date of the Notice of Appeal is not a statutory period and a proper extension of time can be obtained for an additional five months. See 37 CFR § 1.192 and MPEP § 1206.

Petitioner states that he knew that a five month extension of time was available, but that choice (C) was selected because he mistakenly forgot to add the 2 months. Since no error in



grading has been shown and the Examination Directions sets forth “[n]o points will be awarded for incorrect answers,” Petitioner’s request for credit on this question is denied.

Afternoon question 41 reads as follows:

41. Which of the following choices would be considered as independent grounds for filing a reissue application?

- (I) The claims are too narrow or too broad.
  - (II) The disclosure contains inaccuracies.
  - (III) Applicant failed to or incorrectly claimed foreign priority.
  - (IV) The specification contains a plurality of obvious spelling and grammatical errors.
  - (V) Applicant failed to make reference to or incorrectly made reference to prior copending applications.
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- (A) (I), (II), and (IV)
  - (B) (II), (III), and (V)
  - (C) (I), (II), (III), (IV) and (V)
  - (D) (I), (II), (III), and (V)
  - (E) (I), (III), and (V)

The correct answer is (D) because choices (I), (II), (III), and (V) would be considered as independent grounds for filing a reissue application, but not choice (IV). As explained in MPEP § 1402, “The most common bases for filing a reissue application are: (A) the claims are too narrow or too broad; (B) the disclosure contains inaccuracies; (C) applicant failed to or incorrectly claimed foreign priority; and (D) applicant failed to make reference to or incorrectly made reference to prior copending applications.” Accordingly, choices (I), (II), (III), and (V) are correct.

Choice (IV) is not correct because the defect given in choice (IV) does not cause the patent to be deemed wholly or partly inoperative or invalid. MPEP § 1402 provides

In accordance with 35 U.S.C. § 251, the error upon which a reissue is based must be one which causes the patent to be “deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less

than he had a right to claim in the patent.” Thus, an error under 35 U.S.C. § 251 has not been presented where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. § 251. These corrections to a patent do not provide a basis for reissue.

Petitioner selected answer (C) and argues that choice (IV) is an independent ground for filing a reissue application. Petitioner contends choice (IV) “may serve as an independent ground, depending on the severity of the errors.” According to the Petitioner, “[w]hen the spelling and grammatical errors reach to such a[n] amount that, if it causes the patent to be deemed wholly or partly inoperative or invalid, then it would justify filing a reissue application.” Petitioner further infers that the defect recited in choice (IV) “amounts to a level that it in fact may caused the patent to be rendered wholly or partly inoperative or invalid.”

Petitioner’s arguments are not persuasive. The MPEP § 1402 specifically listed the most common bases for filing a reissue application as stated above. The nature of these grounds meets the requirement set forth in 35 U.S.C. § 251, therefore these common defects recited in choices (I),(II),(III), and (V) do not need to state specifically that they cause the patent to be rendered wholly or partly inoperative or invalid. Contrary to these common bases, a plurality of obvious spelling and grammatical errors in the specification, the defect recited in choice (IV), generally would not cause the patent to be rendered wholly or partly inoperative or invalid, unless the facts specifically state that. As explained in MPEP § 1402, “an error under 35 U.S.C. 251 *has not been presented* where the correction to the patent is one of spelling or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251.” Accordingly, the defect recited

in choice (IV) is not an independent grounds for filing a reissue application. Furthermore, Petitioner's inference that the defect recited in choice (IV) does cause the patent to be rendered wholly or partly inoperative or invalid is incorrect. Petitioner assumes facts not presented in the question. Specifically, the obvious spelling and grammatical errors reach to a level that would cause the patent to be rendered wholly or partly inoperative or invalid. Assumption of facts not present is a violation of the Examination Directions. Therefore, answer (C) is not correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 42 reads as follows:

42. On April 19, 1999, Inventor Mary hires you for advice on a patent application. Mary informs you that she previously filed a provisional application for her invention on May 1, 1998. However, Mary has since made some improvements that were not described in her provisional application. To fully protect Mary's patent rights, what is the best course of action to recommend to Mary?

- (A) File an amendment in the provisional application on or before May 1, 1999, which describes the improvements made by Mary.
- (B) Immediately file a continued prosecution application based on the provisional application filed on May 1, 1998, and include a preliminary amendment which adds a description of the improvements made.
- (C) File a second provisional patent application which claims the benefit of the May 1, 1998, filing date of the first provisional patent application.
- (D) File a continuation-in-part application as soon as possible which adds a disclosure of the improvements made.
- (E) None of the above.

Choice (E) is the most correct answer because choices (A), (B), (C), and (D) are not in accordance with proper PTO practice and procedure. Choice (A) is not correct because an amendment to the provisional application describing the Mary's improvements would not comply with 37 CFR § 1.53(c). 37 CFR § 1.53(c) sets forth that "[n]o amendment, other than to make

the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.”

Choice (B) is not correct because a continued prosecution application (CPA) may not be based on a provisional application and a continuation-in-part may not be filed as a CPA. See MPEP § 601.01 (page 600-7). 37 CFR § 1.53(d)(1) sets forth that “[a] continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application”. Furthermore, the preliminary amendment which adds a description of the improvements made would introduce new subject matters.

Choice (C) is not correct because a provisional application is not entitled to the benefit of the earlier filed provisional application. 35 U.S.C § 111(b)(7) sets forth that “NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE. – A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.” Therefore, the second provisional patent application cannot claim the benefit of the May 1, 1998, filing date of the first provisional patent application.

Choice (D) is incorrect because a non-provisional application which relies upon the filing date of a provisional application is not a continuation of the provisional application, so a non-provisional application with additional disclosure over a provisional application would not be a continuation-in-part of the provisional application. Instead, a non-provisional application which claims the benefit of the filing date of a provisional application is an original application. As explained in MPEP § 201.08, “[a] continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application.”

Petitioner selected choice (D) and argues that “there is insufficient information provided[] and the decision is highly fact specific.” Petitioner contends “[u]nder the conditions specified in the question, my chosen choice of answer (D) can be viewed as correct.”

Petitioner’s arguments are not persuasive. Choice (D) is wrong because, as explained in MPEP § 201.08, “[a] continuation-in-part is an application filed during the lifetime of an earlier **nonprovisional** application” (emphasis added) and “[a]n application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a “continuation-in-part of the provisional application since the application will have its patent term calculated from its filing date.” Thus, the MPEP § 201.08 clearly sets forth that a continuation-in-part application is based on a **nonprovisional** application and not a provisional application.

Petitioner’s selection of choice (D) deviates from the procedure sets forth in the MPEP. Accordingly, choice (D) is incorrect. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

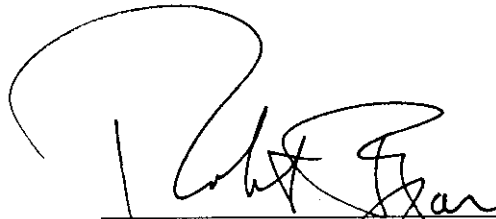
No error in grading has been shown as to questions 7, 16, 38, and 43 of the morning session and questions 31, 41, and 42 of the afternoon session. Petitioner’s request for credit on these questions is denied.

**ORDER**

For the reasons given above, five points have been added to Petitioner's score on the Examination. Therefore, Petitioner's score is adjusted to 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A large, stylized handwritten signature in black ink, appearing to read 'Robert J. Spar', is written over a horizontal line.

Robert J. Spar  
Director, Special Program Law Office  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects